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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,985	01/04/2002	Steven N. Verona	VEROX 101	7751

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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,985

Applicant(s)

VERONA, STEVEN N.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The specification is objected to because the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Oath/Declaration

Response to Amendment

The Declaration filed on February 10, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome both Groner (U.S. Patent No. 6,507,643 B1) and Baxter (U.S. Patent No. 6,385,306 B1) (the "Groner and Baxter references").

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Groner and Baxter references (i.e., either March 2, 2000 or March 16, 2000).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose, however, "there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice."

MPEP § 715.07.III (quoting from In re Asahi/America Inc., 68 F.3d 442, 37 USPQ2d 1204, 1206 (Fed. Cir. 1995)).

For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be in a commercially satisfactory stage of development. If a device is so simple, and

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its purpose and efficacy so obvious, construction alone is sufficient to demonstrate workability.

MPEP § 2138.05.

Here, the applicant has not shown that the apparatus actually existed before the effective date of the Groner and Baxter references, much less that the apparatus worked for its intended purpose or that any testing was performed. For example, the documentary evidence entitled "Wireless Phone Pager" (part of Exhibit A) states certain design features and advantages of the applicant's invention only in vague and general terms. The Declaration fails to provide evidence that the invention actually existed before the effective date.

Further, the applicant admits that the Declaration is directed to an "idea", where this idea was not diligently reduced to practice before the effective date. Specifically, the applicant states that the Wireless Phone Pager document was created when the applicant had "come up with an idea...." Paragraph 3 of the Declaration of February 05, 2005 (also part of Exhibit A) (the "Declaration"). "A conception of an invention, though evidenced by disclosure...is not a complete invention under the patent laws, and confers no rights on an inventor...UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice...."

MPEP § 715.07.III. Regarding further diligent acts to reduce the invention to actual practice, the Declaration only indicates that the applicant was "thinking for a short time about whether it [the invention] would work", that it was "impossible for me to work on all of them [alleged other inventions] at the same time" and that the applicant

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"search[ed]...on the internet generally and on the U.S. patent and Trademark Office website." Declaration, paragraphs 5-7. Thus, the applicant did not perform further diligent acts to reduce the invention to practice. Finally, at the end of 1999, the applicant was only satisfied that the invention "would work" (i.e., the invention's ability to work was expressed in the future tense), thus implying that the invention had still not been reduced to practice. Declaration, paragraph 8.

Although the applicant has provided no evidence of construction as discussed above, mere construction by itself would not be enough to show that the device worked for its intended purpose. Specifically, the Declaration provides evidence that the system is not so simple that a mere construction of it is all that is necessary to constitute reduction to practice. MPEP § 715.07.III (quoting from Asahi/America Inc. as discussed above). For example, the Declarant states that after coming up with the idea for the invention, he had to think "about whether the invention would work." Declaration, paragraph 7. Further, the applicant states that "there was no technology like it available" or that there were no "similar services offered by telephone companies." *Id.*, at paragraph 8. Thus, by applicant's own admission the invention involves unique technology that is not similar to any other systems in existence.

For the above reasons, the Declaration fails to provide sufficient evidence that the invention was diligently reduced to practice before the effective dates of the Groner and Baxter references.

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Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

MPEP § 715.07.III.

Here, there has been no reduction in practice prior to the effective dates of the Groner and Baxter references and the Declaration fails to provide evidence of diligence from a time just prior to the effective dates of the Groner and Baxter references continuously up to the date of an actual reduction to constructive reduction to practice (i.e., filing an application). Thus, the declaration fails to establish the invention of the subject matter of the rejected claims prior to the effective dates of the Groner and Baxter references.

For the above reasons, the applicant's argument's and Declaration were not considered persuasive, and the following rejections are repeated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-17, 18, 20, 23, 25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,507,643 B1 to Groner ("Groner"), as used in the prior Office action.

With respect to claim 1, the caller dials a telephone number for connecting to a central computer (Fig. 1, calling telephone 32 and "voice to electronic" mail system 30, Fig. 11A, step 242). The "voice to electronic" mail system 30 (central computer) compares an intended recipient identifier (called telephone number) with data corresponding to a plurality of subscribers in a subscriber database (recipients e-mail addresses) in order to retrieve the correct e-mail address (Fig. 9 and col. 7, line 66 – col. 8, line 18).¹ The caller can also input a communication code, such as the caller's telephone number (Fig. 11C, step 282).² Groner clearly discloses that the "voice to electronic" mail system 30 (central computer) then constructs an e-mail message addressed to the electronic address of the intended recipient containing information corresponding to the

¹ Interpreting a "intended recipient identifier" as a specific instance of the dialed telephone number is consistent with the applicant's claim structure (e.g., see claim 8).

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communication code (calling party telephone number). The e-mail is transmitted via packet-based network 42, which in one embodiment is the Internet (col. 4, lines 44-48).

With respect to claims 8 and 9, see the claim 1 rejection for further details.

With respect to claim 10, the dialed telephone number comprises alphanumeric.

With respect to claim 11, see Fig. 11C, step 286.

With respect to claims 12-14 and 16-18, the IVR dialogue manager 104 accepts both verbal and touch tone responses (col. 11, lines 43-67).

With respect to claim 15, the calling telephone number would comprise pressing a plurality of touchtone buttons. See the claim 1 rejection for further details.

With respect to claim 20, see the claim 1 rejection for further details.

With respect to claim 23, the e-mail address corresponds to the text display device, which is based is a computer and which is personal in nature (Fig. 1).

With respect to claim 25, see col. 7, lines 41-51.

² Interpreting a "communication code" as the caller's telephone number is consistent with the applicant's

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With respect to claim 27, see Fig. 11D.

With respect to claim 28, reception of an e-mail with an voice attachment would notify the intended recipient of the recorded voice message (Fig. 7).

With respect to claim 29, see col. 4, lines 20-30.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claim 1 above, and further in view of U.S. Patent No. 6,385,306 B1 to Baxter, Jr. ("Baxter"), as used in the prior Office action.

With respect to claim 2, although Groner teaches that the caller may enter the recipient identifier directly, Groner fails to disclose that this identifier is compared with data identifying a plurality of subscribers (col. 16, lines 20-30).

claim structure (e.g., see claim 3).

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However, Baxter (similarly to Groner) teaches of a system for allowing a telephone caller to generate an e-mail (abstract and Fig. 6), where the caller may enter the identifier directly (e.g., a "speed-dial" previously entered email address) that is compared to an address book (compared with data identifying a plurality of subscribers) (Fig. 6, step 240).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the caller inputting the intended recipient identifier that is compared with data as taught by the telephonic e-mail system of Baxter to the process of inputting the intended recipient identifier as disclosed by the telephonic e-mail system of Groner.

The suggestion/motivation for doing so would have been to allow speed dialing codes, which increase the efficiency and user-friendliness of recipient identification by avoiding the need for the "caller...to repeatedly enter in the same email addresses" via a limited capability DTMF interface (Baxter, col. 3, lines 14-23) and to "make the retrieval of the preselected email address as simple as possible (Baxter, col. 6, lines 32-40).

With respect to claims 3 and 5, see the claim 1 rejection for further details.

With respect to claim 4, see Groner, col. 11, lines 60-67.

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With respect to claim 26, see the claim 2 rejection for further details for addition of subscriber's address book facility, where the user modifies electronic (e-mail) addresses stored in the address book. Further, "Official Notice" is taken that both the concept and advantage of allowing the user to access this address book for modification purposes via the Internet would have been well known and expected in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to make modification of electronic addresses in the address book disclosed by Groner in view of Baxter available via the Internet.

The suggestion/motivation for doing so would have been to increase the accessibility of user data by providing that data via the Internet, which would have been notoriously well known in the art.

With respect to claim 6 and 7, the IVR dialogue manager 104 accepts both verbal and touch tone responses (Groner, col. 11, lines 43-67).

Claims 19, 21, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groner as applied to claims 1, 18, 20 above.

Although Groner discloses sending the e-mail to a text display device (Fig. 1), Groner fails to disclose that this text display device processes instant messaging and web mail and whether the device is a PDA or wireless.

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However, "Official Notice" was taken in the last Office action that both the concept and advantages of a personal text display devices processing instant messaging and web mail in the form of PDAs and wireless devices would have been well known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the last Office action is taken as an admission of the facts noticed.

Therefore, it would have been obvious to add to the text display device disclosed by Groner the processing of instant messaging and web mail in the form of a PDA and wireless device.

The suggestion/motivation for doing so would have been to increase the accessibility and reach of e-mail devices by supporting web mail and instant messaging and to support typical e-mail devices such as PDAs and wireless pagers and phones as is notoriously well known in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland G. Foster whose telephone number is (571) 272-7538. The examiner can normally be reached on Mon to Fri from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roland G. Foster
Primary Patent Examiner
May 5, 2005